

ESTTA Tracking number: **ESTTA564363**

Filing date: **10/10/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Siemens Medical Solutions USA, Inc.
Granted to Date of previous extension	10/12/2013
Address	51 Valley Stream Parkway Malvern, PA 19355 UNITED STATES
Attorney information	Jill Anderfuren Marshall, Gerstein & Borun LLP 233 S. Wacker Drive Chicago, IL 60606 UNITED STATES janderfuren@marshallip.com Phone:3124746300

Applicant Information

Application No	85886016	Publication date	08/13/2013
Opposition Filing Date	10/10/2013	Opposition Period Ends	10/12/2013
Applicant	InnoPath Software, Inc. 1195 W. Fremont Avenue Sunnyvale, CA 94087 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 009.</p> <p>All goods and services in the class are opposed, namely: Mobile device software for use by mobile device users to receive product support and updates for mobile device operating systems and features; mobile device software for monitoring, diagnosing, and fixing mobile device problems and providing helpful advice when using the mobile device; mobile device software for use by mobile device users to facilitate real-time connection and communication with customer support representatives for the diagnosis and repair of mobile devices</p>
<p>Class 042.</p> <p>All goods and services in the class are opposed, namely: Software as a Service (SaaS) for use by mobile device operators, manufacturers, and independent services providers to deliver product support and updates for mobile device operating systems and features; Software as a Service (SaaS) for use by mobile device operators, device manufacturers, and independent operators to remotely monitor, diagnose, and correct mobile device problems; Software as a Service (SaaS) for use by mobile device operators, device manufacturers, and independent service providers to connect and communicate in real-time with mobile device users to remotely monitor, diagnose and fix mobile devices</p>

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4005257	Application Date	10/12/2010
Registration Date	08/02/2011	Foreign Priority Date	NONE
Word Mark	MOBILEMD		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1999/02/05 First Use In Commerce: 1999/02/05 Computer programs and software used to provide Health Information Services, namely, providing transmission, storage and management of health information via the Internet and between computer systems, handheld devices and telecommunication devices of health care providers including health systems, hospitals, physician practices, practices, testing and laboratory companies, medical billing companies and others and other health care providers and/or their respective business partners and/or contractors</p> <p>Class 038. First use: First Use: 1999/02/05 First Use In Commerce: 1999/02/05 Communication services relating to health information, namely, providing electronic transmission of health information accessed via the Internet and between computer systems, handheld devices and telecommunication devices of health care providers including health systems, hospitals, physician practices, practices, testing and laboratory companies, medical billing companies and others and other health care providers and/or their respective business partners and/or contractors</p> <p>Class 042. First use: First Use: 1999/02/05 First Use In Commerce: 1999/02/05 Providing online non-downloadable software for the storage and management of health care information via the Internet and between computer systems, handheld devices and telecommunication devices of health care providers including health systems, hospitals, physician practices, practices, testing and laboratory companies, medical billing companies and others and other health care providers and/or their respective business partners and/or contractors</p>		

U.S. Registration No.	4005257	Application Date	10/12/2010
Registration Date	08/02/2011	Foreign Priority Date	NONE
Word Mark	MOBILEMD		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1999/02/05 First Use In Commerce: 1999/02/05 Computer programs and software used to provide Health Information Services, namely, providing transmission, storage and management of health information via the Internet and between computer systems, handheld devices and telecommunication devices of health care providers including health systems,</p>		

	<p>hospitals, physician practices, practices, testing and laboratory companies, medical billing companies and others and other health care providers and/or their respective business partners and/or contractors</p> <p>Class 038. First use: First Use: 1999/02/05 First Use In Commerce: 1999/02/05</p> <p>Communication services relating to health information, namely, providing electronic transmission of health information accessed via the Internet and between computer systems, handheld devices and telecommunication devices of health care providers including health systems, hospitals, physician practices, practices, testing and laboratory companies, medical billing companies and others and other health care providers and/or their respective business partners and/or contractors</p> <p>Class 042. First use: First Use: 1999/02/05 First Use In Commerce: 1999/02/05</p> <p>Providing online non-downloadable software for the storage and management of health care information via the Internet and between computer systems, handheld devices and telecommunication devices of health care providers including health systems, hospitals, physician practices, practices, testing and laboratory companies, medical billing companies and others and other health care providers and/or their respective business partners and/or contractors</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/ja/
Name	Jill Anderfuren
Date	10/10/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Re:
Application Serial No.: 85/886,016
Trademark: MOBILEMD
Applicant: InnoPath Software, Inc.
International Class(es): 9 and 42
Filed: March 25, 2013
Published in Official Gazette of August 13, 2013

Siemens Medical Solutions USA, Inc.,	:
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Opposer,	:
	:
- vs. -	:
	:
InnoPath Software, Inc.,	:
	:
Applicant.	:
	:

NOTICE OF OPPOSITION

Siemens Medical Solutions USA, Inc. (“Opposer”), a Delaware Corporation with a principal place of business at 51 Valley Stream Parkway, Malvern, Pennsylvania 19355, believes that it will be damaged by the registration by InnoPath Software, Inc. (“Applicant”) of the mark that is the subject of the above-identified application (the “Application”), and hereby opposes the same.

The grounds for the opposition are as follows:

1. Opposer, or its predecessor in interest commenced use in commerce, at least as early as February 5, 1999, and is presently using and has registered the trademark MobileMD (“Opposer’s Mark”), in connection with the following goods and services:

Class 9: Computer programs and software used to provide Health Information Services, namely, providing transmission, storage and management of health information via the Internet and between computer systems, handheld devices and telecommunication devices of health care providers including health systems, hospitals, physician practices, practices, testing and laboratory companies, medical billing companies and others and other health care providers and/or their respective business partners and/or contractors

Class 38: Communication services relating to health information, namely, providing electronic transmission of health information accessed via the Internet and between computer systems, handheld devices and telecommunication devices of health care providers including health systems, hospitals, physician practices, practices, testing and laboratory companies, medical billing companies and others and other health care providers and/or their respective business partners and/or contractors

Class 42: Providing online non-downloadable software for the storage and management of health care information via the Internet and between computer systems, handheld devices and telecommunication devices of health care providers including health systems, hospitals, physician practices, practices, testing and laboratory companies, medical billing companies and others and other health care providers and/or their respective business partners and/or contractors

2. Opposer’s Mark is the subject of the following United States trademark registration: Reg. No. 4,005,257 issued August 2, 2011, based on USSN 85/150,428 filed October 12, 2010.

3. By virtue of the Opposer’s continuous use of Opposer’s Mark, and Opposer’s promotional activities, and by virtue of the quality of the goods and services offered under Opposer’s Mark, Opposer’s Mark has developed goodwill and consumer recognition.

4. Applicant filed an application for the mark MOBILEMD on March 25, 2013 (“Applicant’s Mark”) for “Mobile device software for use by mobile device users to receive product support and updates for mobile device operating systems and features; mobile device software for monitoring, diagnosing, and fixing mobile device problems and providing helpful advice when using the mobile device; mobile device software for use by mobile device users to facilitate real-time connection and communication with customer support representatives for the diagnosis and repair of mobile devices” in Class 9 and “Software as a Service (SaaS) for use by mobile device operators, manufacturers, and independent services providers to deliver product support and updates for mobile device operating systems and features; Software as a Service (SaaS) for use by mobile device operators, device manufacturers, and independent operators to remotely monitor, diagnose, and correct mobile device problems; Software as a Service (SaaS) for use by mobile device operators, device manufacturers, and independent service providers to connect and communicate in real-time with mobile device users to remotely monitor, diagnose and fix mobile devices” in Class 42 (“Applicant’s Goods and Services”).

5. There is no issue as to priority. Opposer commenced use of Opposer’s Mark in commerce, well prior to Applicant’s March 25, 2013 filing date of its intent-to-use Application for MOBILEMD.

6. Applicant’s Mark is confusingly similar to Opposer’s Mark, so as to cause confusion and deceive the public as to origin of Applicant’s goods and services to be offered under Applicant’s Mark. Consumers and persons will assume, contrary to fact, that Applicant’s goods and services are associated with, endorsed by or in some other way related to Opposer and/or Opposer’s goods and services.

7. Applicant's Mark is deceptively similar to Opposer's Mark so as to cause confusion and deceive the public as to the origin of Applicant's goods and services to be offered under Applicant's Mark. Consumers and persons in the trade will assume, contrary to the fact, that Applicant's goods and services are associated with, endorsed by or in some other way related to Opposer and/or Opposer's goods and services.

8. Opposer alleges and believes, for the reasons set forth above, that if Applicant is permitted to use and/or register Applicant's Mark in connection with Applicant's goods and services, as specified in the Application, confusion would occur, resulting in damage and injury to Opposer.

9. If Applicant is granted the registration herein opposed, Applicant would thereby obtain at least a prima facie exclusive right to the use of Applicant's Mark. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer, respectfully requests that this opposition be sustained in favor of Opposer and that registration of Applicant's Mark be rejected and denied.

Opposer, Siemens Medical Solutions USA, Inc., hereby appoints Jill Anderfuren, Julianne M. Hartzell, and all attorneys of Marshall, Gerstein & Borun LLP of 233 S. Wacker Drive, Suite 6300, Chicago, Illinois 60606-6357 to act as attorneys for Opposer herein, with full power to prosecute said Opposition, to transact all relevant business with the Patent and Trademark Office and in the United States Courts and to receive all official communication in connection with this opposition.

Payment in the amount of \$600.00 is made to cover the cost of the opposition. The Director is hereby authorized to charge any additional fees that may be required to Deposit Account Number 13-2855.

Respectfully submitted,
Siemens Medical Solutions USA Inc.



Jill Anderfuren
Attorney for Opposer

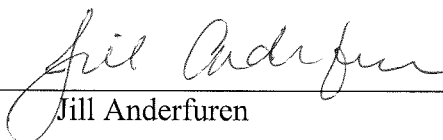
Date: October 10, 2013

CONTACT:
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CERTIFICATE OF SERVICE

I hereby certify that a true and exact copy of the foregoing **NOTICE OF OPPOSITION** was mailed to the following persons by first class mail, postage prepaid, on: October 10, 2013

Maren C. Perry
King & Spalding LLP
1185 Avenue of the Americas
New York, NEW YORK 10036



Jill Anderfuren